

REMARKS

This Application has been carefully reviewed in light of the Office Action dated September 25, 2008 (“*Office Action*”). At the time of the *Office Action*, Claims 1-24 were pending and rejected. Applicants have amended Claims 1, 4, 8, 10, 13, and 20 and cancelled Claim 12. Applicants add new Claims 25-27. Applicants submit that no new matter has been added by these amendments. As described below, Applicants believe all claims to be allowable over the cited references. Therefore, Applicants respectfully request reconsideration and full allowance of all pending claims.

Section 101 Rejections

The Examiner rejects Claims 1-6 and 8-24 under 35 U.S.C. § 101 because the claimed invention is directed to nonstatutory subject matter. Specifically, the Examiner states that “a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials).” (*Office Action*, page 2). It is the Examiner’s position that “[t]he claim language does not include the required tie or transformation and thus is directed to nonstatutory subject matter.” (*Office Action*, page 2). Without conceding the veracity of the rejection, Applicant has amended independent Claim 1 to recite “using one or more computer systems to provide the customer with a return label to be placed on the package.” Likewise, Claim 20 has been amended to recite “using one or more computer-systems to provide the customer with a return label to be placed on the package” and “using one or more computer-systems to notify the customer that, by using the return label, returns are pre-authorized and that carrier costs are due subsequent to the initiation of the return.” Thus, at least the amended language of Claims 1 and 20 make clear that the methods are tied to a computing system. Because a computer system is a “machine,” the methods of Claims 1 and 20 are “tied to a particular machine.” Therefore, the methods recited in Claims 1 and 20 constitute statutory subject matter under 35 U.S.C. § 101 according to the applicable case law.

For at least these reasons, Applicant respectfully submits that independent Claims 1 and 20 and their respective dependent claims meet the requirements of 35 U.S.C. § 101 and respectfully request that the 35 U.S.C. § 101 rejections of these claims be withdrawn. Favorable action is requested.

Section 112 Rejections

The Examiner rejects Claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner states it is not clear as to what the scope of “conforms to the USPS merchandise return service specifications” is. (*Office Action*, page 3). Applicants have amended the claims to address the antecedent basis issues identified by the Examiner. Applicants respectfully request that the rejections under 35 U.S.C. § 112, second paragraph be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 1-5, 7-12, 14-21, and 23 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,536,659 issued to Hauser et al. (“*Hauser*”). Applicants respectfully request reconsideration for at least the following reasons.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. ch. 2131. “The *identical invention* must be shown in as *complete detail as contained* in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis added); see also M.P.E.P. ch. 2131. In addition, “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. ch. 2131.

The Federal Circuit recently clarified this standard in *Net Moneyin, Inc. v. Verisign, Inc.*, 2008 WL 4614511 (Fed. Cir. 2008). In *Net Moneyin*, the Federal Circuit held that a finding of anticipation under 35 U.S.C. § 102 is proper only when a “reference discloses within the four corners of the document not only all of the limitations claimed but also *all of the limitations arranged or combined in the same way* as recited in the claim.” *Net Moneyin* at *10 (emphasis added). The prior art reference must “*clearly and unequivocally* disclose the claimed invention . . . *without any need for picking, choosing, and combining various disclosures not directly related to each other by* the teachings of the cited reference.” *Id.* (emphasis added, internal typographical notations omitted).

Independent Claim 1 of the present Application, as currently amended, recites:

A method, performed by a returns provider, of enabling a customer to ship a package containing one or more items previously acquired from a merchant during a unique transaction, comprising the step of:

using one or more computer-systems to provide the customer with a return label to be placed on the package, the label containing a shipping destination of the package and integrated machine readable data representing at least a shipping origin of the package and identification of the transaction;

using a shipping carrier service to transport the package to the shipping destination, the package shipped to the shipping destination using “reverse zone skipping” wherein the shipping destination is a carrier center near a returns center associated with the returns provider; and

receiving, by the returns provider, the package at the carrier center for transportation to the returns center.

Whether considered alone or in combination with any other cited references, *Hauser* does not disclose, either expressly or inherently, each and every element of the claims.

For example, *Hauser* does not disclose, teach, or suggest “using a shipping carrier service to transport the package to the shipping destination, the package shipped to the shipping destination using “reverse zone skipping” wherein the shipping destination is a carrier center near a returns center associated with the returns provider” and “receiving, by the returns provider, the package at the carrier center for transportation to the returns center,” as recited in Claim 1. *Hauser* discloses that “the customer will be the party that ships the merchandise being returned to the return facility.” (*Hauser*, Column 3, line 67 through Column 4, line 2). *Hauser* further discloses that the shipping label will include “the address for Returns Online, Inc.” and that the label can be used “to facilitate shipment of the merchandise to Returns Online, Inc.” (*Hauser*, Column 4, lines 16-35). Thus, *Hauser* does not disclose, teach, or suggest “using a shipping carrier service to transport the package to the shipping destination, the package shipped to the shipping destination using “reverse zone skipping” wherein the shipping destination is a carrier center near a returns center associated with the returns provider” and “receiving, by the returns provider, the package at the carrier center for transportation to the returns center,” as recited in Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of independent Claim 1, together with Claims 2-5, 7-11, and 14-19 that depend on Claim 1. For

analogous reasons, Applicants request reconsideration and allowance of independent Claim 20, together with Claims 21 and 23 that depend on Claim 20.

Section 103 Rejections

The Examiner rejects Claims 6, 22, and 24 under 35 U.S.C. 103(a) as being unpatentable over *Hauser*. The Examiner rejects Claim 13 under 35 U.S.C. 103(a) as being unpatentable over *Hauser* in view of U.S. Patent No. 6,085,172 issued to Junger ("*Junger*").

Each of dependent Claims 6, 13, 22, and 24 depend on one of Claims 1 and 20, which Applicants have shown above to be allowable. Accordingly, dependent Claims 6, 13, 22, and 24 are not obvious over *Hauser* or the proposed *Hauser-Junger* combination at least because Claims 6, 13, 22, and 24 include the limitations of their respective independent claims. Since Claims 6, 13, 22, and 24 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 6, 13, 22, and 24. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 6, 13, 22, and 24.

For at least these reasons, Applicants request reconsideration and allowance of Claims 6, 13, 22, and 24.

New Claims 25-27 are Allowable

New Claims 25-27 have been added and are fully supported by the original specification. No new matter has been added. New Claims 25-27 depend upon independent Claim 1. Claims 25-27 are allowable over *Hauser*, whether considered alone or in combination with *Junger*, because Claims 25-27 include the limitations of Claim 1 and add additional elements that further distinguish the art. For example, Claim 25 recites that "prior to receiving the package at the carrier center near the returns center, receiving the package at a first carrier station nearest the customer" and "using the shipping carrier service to transport the package from the first carrier station to the final destination at the carrier station near the returns center for pickup by a returns provider." Claim 26 recites that "the carrier station near the returns center comprises a regional bulk mail center closest to a location of the returns provider." Claim 27 recites "assessing a shipping charge for the package to calculate the shipping charge for transporting the package from a postal code associated with the customer to the regional bulk mail center." The features recited in Claims 25-27 are not disclosed,

taught, or suggested in the prior art of record. For at least these reasons, Applicants respectfully submit that new Claims 25-27 are allowable over the prior art.

No Waiver

Additionally, Applicants have merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the Examiner's rejections.

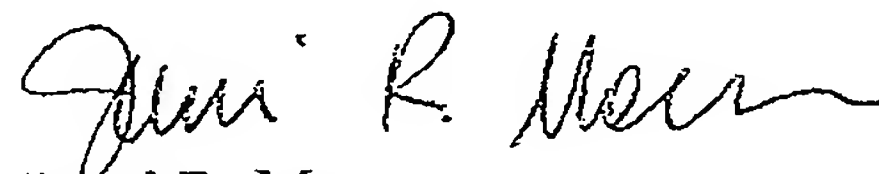
CONCLUSION

Applicants have made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicants, at the Examiner's convenience at (214) 953-6809.

The Commissioner is hereby authorized to charge \$52.00 for additional claims to Deposit Account No. 02-0384 of Baker Botts L.L.P. Although no other fees are believed due, the Commissioner is hereby authorized to charge any fees or credits to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants


Jenni R. Moen
Reg. No. 52,038

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Correspondence Address:

at Customer Number: **05073**